

REMARKS

I. Summary of the Office Action

Claims 1, 2, 6, 8, 11-18, 35, 36, 41, 44-48, and 60-63 were pending in this application.

Claims 11 and 44 were rejected under 35 U.S.C. § 112, second paragraph.

Claims 1, 6, 8, 12, 13, 16-18, 35, 41, 45 and 48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Young et al. U.S. Patent No. 5,353,121 ("Young") in view of Goldschmidt Iki et al. U.S. Patent No. 6,483,987 ("Iki") and further in view of Barton et al US 2001/0049820 ("Barton").

Claims 2, 11, 14, 15, 36, 44, 46, 47, 62 and 63 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Young in view of Iki and Barton, and further in view of Zigmond et al. U.S. Patent No. 6,698,020 ("Zigmond").

Claims 60 and 61 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Young in view of Iki, Barton and Zigmond, and further in view of Michaud WIPO Publication No. WO 99/57904 ("Michaud").

II. Summary of the Applicants' Reply

Applicants have cancelled claims 11 and 44 without prejudice. For at least this reason, the 35 U.S.C. § 112 rejections of claims 11 and 44 should be withdrawn.

The Examiner's prior art rejections are respectfully traversed.

III. Applicants' Reply to the § 112 Rejection

Claims 11 and 44 were rejected under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite. Applicants have cancelled claims 11 and 44 without prejudice. For at least this reason, applicants respectfully request that the Examiner's rejection of claims 11 and 44 under 35 U.S.C. § 112, second paragraph, be withdrawn.

IV. Applicants' Reply to the § 103 Rejection

Claims 1, 6, 8, 12, 13, 16-18, 35, 41, 45 and 48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Young in view of Iki and further in view of Barton. Claims 2, 11, 14, 15, 36, 44, 46, 47, 62 and 63 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Young in view of Iki and Barton, and further in view of Zigmund. Claims 60 and 61 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Young in view of Iki, Barton and Zigmund, and further in view of Michaud. These rejections are respectfully traversed.

Applicants' independent claims 1 and 35 refer to, *inter alia*, a method and system for providing an integrated recorded program/promotion playback asset. The program/promotion playback asset is a customized playback experience of recorded programming in that one or more promotions are insertably recorded with the recorded programming such that during playback, the recorded promotion(s) appear as if they were originally part of the recorded programming. As required by independent claims 1 and 35, a promotion is selected for inclusion in the

program/promotion playback asset, and the selected promotion is inserted at one of the beginning of the recorded selected program or the end of the recorded selected program in response to determining that the selected program is to be recorded. In other words, applicants' claims allow for the creation of a program/promotion playback asset that, when watched, is plainly different than if the user had been watching a program on live television or a recorded version of the live television program.

Young relates to a television schedule system that allows a user to control operation of a VCR through on screen television program listings. Young, column 1, lines 19-24.

Iki relates to a graphical user interface that allows a user to record a broadcast data selection without commercials by determining whether a commercial or program is being broadcast, and stopping the recording if a commercial is being broadcast. Iki, FIG. 7, column 8, line 59 to column 9, line 7 and column 9, lines 15-31.

Barton refers to a bookending function that displays an advertisement before and/or after a program that has been recorded on the DVR's storage device is played to the viewer. The viewer selects a recorded program from the DVR's storage device to playback. Before the program is played back, an advertisement is retrieved from the storage device and is displayed before the program is run. Another advertisement is retrieved and then played after the program is over. Barton, abstract.

Applicants respectfully submit that Young, Iki, and Barton, taken either alone or in combination, fail to show or

suggest every element of applicants' independent claims 1 and 35. Specifically, Young, Iki and Barton do not show, in response to determining whether a selected program is to be recorded, recording the selected promotion for inclusion in an integrated recorded program/promotion playback asset such that the selected promotion is inserted at one of the beginning of a recorded selected program or the end of the recorded selected program.

Young merely allows a user to control operation of a VCR through on screen television program listings. Nowhere does Young show or suggest a causal link between selecting a program to record on the VCR, and recording a selected promotion with the selected program.

The Examiner asserts that "Iki discloses selecting a promotion to record for inclusion in the integrated recorded program/promotion playback asset; recording the selected promotion for inclusion in the integrated recorded program/promotion playback asset (see col. 8, line 59-col. 10, line 5; Fig. 5-8)." Office Action, page 6. The Examiner further contends that "it would have been obvious . . . to have an option of recording as taught by Iki to the recording system of Young in order to provide a system automatically records television program either with or without commercials (see col. 1, lines 19-46)." Office Action, page 6. Applicants respectfully disagree.

Iki shows a recording scheme that either eliminates all commercials from a recorded program, or allows for the recording of a program with all of the commercials that were broadcast along with the program. Iki does not show or suggest

a causal link between selecting a program to record, selecting a promotion and recording the selected promotion with the selected program. Instead, when a user of Iki wishes to record a program with commercials, Iki simply records the broadcast program including all of the commercials that were broadcast along with the program.

Moreover, Iki's recording scheme teaches away from applicants' claimed approach because it either completely eliminates all commercials from a recorded program, or allows for the recording of program with all of the commercials that were originally broadcast with the program. Specifically, Iki's system attempts to improve upon prior video recording devices by "automatically inhibit[ing] the recording of unwanted advertising commercials." Col. 1, lines 31-35. This recording scheme is the complete opposite of applicants' insertion of selected commercials into a recorded program. Accordingly, because Iki includes or eliminates all commercials rather than selecting commercials to insert in a recorded program, Iki teaches away from being included in a combination with Young and Barton.

The Examiner concedes that Young and Iki do not disclose applicants' previously claimed step of inserting the advertisement at one of the beginning of the program or the end of the program. To remedy this deficiency, the Examiner relies on Barton.

However, Barton merely discloses retrieving an advertisement, and playing the advertisement before and/or after a previously recorded program is played. Nowhere does Barton show or suggest the selection of a promotion to be

recorded with a program in response to determining that a selected program is to be recorded. In other words, Barton does not show or suggest, as required by applicants' claims, recording the selected promotion for inclusion in the integrated recorded program/promotion playback asset, in response to determining that a selected program is to be recorded.

Accordingly, for at least these reasons, applicants respectfully submit that independent claims 1 and 35 and claims 2, 6, 8, 12-18, 36, 41, 45-48, and 60-63 which depend, directly or indirectly, from claims 1 or 35 are allowable.

V. Conclusion

In view of the foregoing, claims 1, 2, 6, 8, 12-18, 35, 36, 41, 45-48, and 60-63 are allowable. This application is therefore in condition for allowance. Reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,

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